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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,475	03/19/2001	Hideki Yoneda	P20480	8984

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EXAMINER

KESACK, DANIEL

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/810,475	YONEDA, HIDEKI	
	Examiner	Art Unit	
	Dan Kesack	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/28/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed February 28, 2006 has been entered and considered. Original claims 1-24 have been cancelled. New claims 25-48 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 36 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 36 is drawn to the steps of indicating price reduction factors numerically, and providing services where the commodities are traded at reduced prices according to the trading recording files. The specification does not describe these steps in such a way as to enable one of ordinary skill in the art to indicate any such price reduction

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factors. Further, the specification does not provide details of the correlation between the trading recording files and the trading at reduced process. Therefore, one of ordinary skill in the art would not be enabled to provide the services, as claimed in the method.

Claim 48 is drawn to a system further comprising a recorder and a provider. The specification does not mention any such "recorder", nor does it mention a provider providing such services, as recited in claim 48.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claims 36 and 48, the phrase "and other trouble factors" renders the claims indefinite because the claims include elements not actually disclosed in the claims or the specification, thereby rendering the scope of the claim(s) unascertainable.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 25-35, 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al., U.S. Patent No. 5,724,524 in view of Chou et al., U.S. Patent No. 6,240,400.

Claims 25, 29, 35, 37, 41, 48, Hunt discloses a system and method for listing and brokering a commodity, comprising connecting to a trading server (figure 1, #12), displaying an input screen (column 5 lines 23-25, figure 2), inputting information associated with the commodity, and whether it is a buy or sell action (column 4 lines 63-65, figure 3), sending the information to the trading server (figure 1), storing trade information in the trading server (column 10 lines 55-60), and wherein trading information is searchable and codes associated with the trading information include attribute information, prices and sizes, are judged to match trades (column 7 lines 60-67 and column 8 lines 16-18).

Claims 25, 29, 37, 41, Hunt fails to teach the commodity being a manufacturing capacity, and the attribute information being product types, and yield information.

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Chou discloses a system and method for accommodating electronic commerce wherein commodities are bought, sold, and traded, wherein the commodity being traded comprises capacity in semiconductor manufacturing, defined by the type of chip, the size, the quantity, the process required, and the date required by. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hunt to include the commodity being a semiconductor manufacturing capacity because of the various cost and production benefits gained in a trade of manufacturing capacity as taught by Chou (column 1 lines 21-35).

Claims 35, 48, Hunt fails to teach the commodity being intellectual property. However, Applicant has acted as his or her own lexicographer on page 2 of the specification, by providing a definition of Intellectual Property as "the information and technologies which are necessary to design and manufacture products." Accordingly, Examiner notes that the manufacturing capacity of semiconductors as taught by Chou, is regarded as an intellectual property, as defined by the Applicant.

Claims 26, 38, Hunt teaches a trader can select one of a plurality of listed trade information which passed the judging (column 5 lines 18-25).

Claim 27, 28, 40, 41, Hunt teaches a trade is made between traders who offer a pair of trade information when the pair of trade information is the only pair that passed the judging (figure 5A, #164, 168, 170). Further, in this embodiment, the pair which passed the judging would be the most favorable offer identified by trading site server.

Claims 30, 32, 42, 44, Hunt teaches trading rights to sell or buy manufacturing capacity at predetermined prices on predetermined dates, and where a penalty is calculated according to a standard and is posed to the seller in a trade when the yield does not reach the yield included in the attribute information (column 11 lines 42-54).

Claims 31, 43, Hunt teaches, as described above, that agreements between traders can be made for trades to be completed at a predetermined date in the future. Therefore, it is inherent that a trader may trade more service than they can currently accommodate, in anticipation of being able to accommodate said services at the future point in time named in the agreement. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to allow for such agreements to be made, and is presented in the Applicant's claimed invention as the Applicant's intended use.

Claims 33, 45, Hunt fails to teach the commodity being a capacity of semiconductor wafer process, semiconductor packaging process and semiconductor testing process capacity.

Chou teaches a commodity consisting of semiconductor wafer manufacturing capacity (column 2 lines 60-67). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hunt to include the commodity being a semiconductor manufacturing capacity because of the various

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cost and production benefits gained in a trade of manufacturing capacity as taught by Chou (column 1 lines 21-35).

Claims 34, 46, Hunt teaches inputting attribute information related to the trade of the commodity, and the use of code information and indicating said code information automatically (column 7 lines 61-67), but fails to teach the attribute information being related to manufacturing capacity, including the quantity of product, specification of the product and design rules. Chou teaches commodity involved in trading being a manufacturing capacity, and indicating detailed information to a trader including a quantity, a specification, and the process required (column 2 line 60 – column 3 line 3). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hunt to include the commodity being a semiconductor manufacturing capacity because of the various cost and production benefits gained in a trade of manufacturing capacity as taught by Chou (column 1 lines 21-35).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Sequencia" from M2 Presswire details an Internet site where one can buy and sell manufacturing capacity.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER